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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,283	01/02/2002	Tadahiko Furuta	217522US0PCT	1457

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EXAMINER

SHEEHAN, JOHN P

ART UNIT PAPER NUMBER

1742

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/019,283

Applicant(s)

FURUTA ET AL.

Examiner

John P. Sheehan

Art Unit

1742

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY (check either a) or b)

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

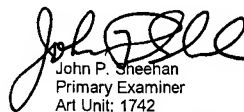
Claim(s) allowed: _____.

Claim(s) objected to: 5, 7-10 and 16-18 as drawn to allowable subject matter but dependent on a rejected independent claim.

Claim(s) rejected: 1-4, 6 and 15.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


John P. Sheehan
Primary Examiner
Art Unit: 1742

Continuation of 2. NOTE: The addition of the cold rolling step to product claim 1 changes product claim 1 to a product by process claim and therefore raises new issues that require further consideration, such as for example, does this process limitation in claim 1 lend patentability to the claimed product? Further, the new claim language, "is subjected to cold-working" raises the issue regarding whether the titanium alloy member has actually been subjected to the recited cold working step or whether the titanium alloy member is merely capable of being subjected to cold working. Additionally, claim 15 would be redundant in view of the proposed amendment to claim 4.

Continuation of 5. does NOT place the application in condition for allowance because: The declaration under 37 CFR 1.132 filed May 20, 2004 is insufficient to overcome the rejection of claims 1 to 3, 4, 6 and 15 based upon Ahmed as set forth in the last Office action because:

I. The declaration presents only one alloy representing the instantly claimed invention, in view of this, the declaration is not persuasive in that it is not commensurate in scope to the claimed invention, MPEP 716.02(d). General superiority cannot be inferred from the results obtained using a single embodiment of the claimed invention, In re Greenfield, 197 USPQ 227, 230 and MPEP 2144.08 (B).

II. Applicants "have the burden of explaining the data in any declaration they proffer as evidence of non-obviousness" Ex parte Ishizaka 24 USPQ2d 1621, 1624 (Bd. Applicant. & Inter. 1992)", MPEP 716.02(c). Applicants have not explained the proffered data, for example applicants have not explained what the purpose of the declaration is, how the declaration fulfills this purpose and which claims is the declaration relevant to and why.